



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/773,009

02/05/2004

Andrew Harvey Barr

200208802-1

5356

22879

7590

06/06/2006

HEWLETT PACKARD COMPANY
P O BOX 272400, 3404 E. HARMONY ROAD
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

TA, THO DAC

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/773,009	Applicant(s) BARR, ANDREW HARVEY	
	Examiner Tho D. Ta	Art Unit 2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 23, 30 and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendment regarding “wherein one circuit board includes the first and second circuits” is a **new matter**. Applicant has not pointed out where is this amendment come from because the originally filed specification and the drawing do not disclose it.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, it is unclear if “a circuit board” recited in lines 3 and 4 is a “new circuit board” or the same circuit board recite in line 2.

Claim 13, it is unclear if "a circuit board" recited in line 6 is a "new circuit board" or the same circuit board recite in line 3.

Claim 24, it is unclear if "a circuit board" recited in lines 5 and 6 is a "new circuit board" or the same circuit board recite in line 3.

For purpose of examination, Examiner assumes one circuit board includes the first and second circuits.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4, 6, 11-13-15, 17, 22, 23, 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Thrush et al. (5,403,195).

In regard to claim 1, Thrush et al. discloses a connector comprising: a first contact 20 that contacts a conductor of a first circuit in a circuit board (not shown); a second contact 20 that contacts a conductor of a second circuit in a circuit board (not shown); and a capacitor 30 coupled between the first and second contacts 20, the capacitor 30 being serially coupled only to the first and second contacts 20 whereby, the connector capacitively couples the conductor of the first circuit to the conductor of the second circuit.

In regard to claim 2, Thrush et al. discloses that an electrically insulative

Art Unit: 2833

body 10 encapsulating the capacitor 30 and carrying the first and second contacts 20.

In regard to claim 3, Thrush et al. discloses that the second contact 20 is a male contact 26.

In regard to claim 4, Thrush et al. discloses that the first contact 20 is a female contact 24.

In regard to claim 6, Thrush et al. discloses the first and second contacts 20 are disposed substantially transverse to each other.

In regard to claim 11, Thrush et al. discloses the first circuit is an integrated circuit (this socket is a DIP socket and 24 is connected to an IC).

In regard to claim 12, Thrush et al. discloses the second circuit is a PCB (26 is connected to PCB)

In regard to claim 13, Thrush et al. discloses a connector comprising: an insulative body 10; a first contact 20 carried by the body 10 that contacts a conductor of a first circuit in a circuit board (not shown); a second contact 20 carried by the body 10 that contacts a conductor of a second circuit in a circuit board (not shown); and a capacitor 30 encapsulated within the body 10 and coupled between the first and second

Art Unit: 2833

contacts 20, the capacitor 30 being serially coupled only to the first and second contacts 20 whereby, the connector capacitively couples the conductor of the first circuit to the conductor of the second circuit.

In regard to claim 14, Thrush et al. discloses that the second contact 20 is a male contact 26.

In regard to claim 15, Thrush et al. discloses that the first contact 20 is a female contact 24.

In regard to claim 17, Thrush et al. discloses the first and second contacts 20 are disposed substantially transverse to each other.

In regard to claim 22, Thrush et al. discloses the first circuit is an integrated circuit (this socket is a DIP socket and 24 is connected to an IC).

In regard to claim 23, Thrush et al. discloses the second circuit is a PCB (26 is connected to PCB).

In regard to claim 30, Thrush et al. discloses that one circuit board includes the first and second circuits.

Allowable Subject Matter

7. Claims 24-27, 31 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
8. Claims 5, 7-10, 16, 18-21, 28, 29 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
9. The following is a statement of reasons for the indication of allowable subject matter: In regard to claims 5, 16, the prior art fails to provide, teach or suggest that the first and the second contacts are disposed along a substantially common line; and in combination with all of the limitations of the base claim and any intervening claims. In regard to claims 7, 18, the prior art fails to provide, teach or suggest that a plurality of first contacts, a like plurality of second contacts, and a like plurality of capacitors, each capacitor coupled between a different respective pair of the first and second contacts; and in combination with all of the limitations of the base claim and any intervening claims. In regard to claim 24, the prior art fails to provide, teach or suggest the combination of a first contact and a second contact contacting a circuit board; and a like plurality of capacitors coupled between respective pairs of the first and second contacts each capacitor being serially coupled to a respective pair of the first and second contacts whereby, the connector capacitively couples each conductor of the first circuit to a corresponding respective conductor of the second circuit.

Response to Arguments

10. Applicant's arguments filed 3/9/06 have been fully considered but they are not persuasive.

In response to applicant's argument regarding the Thrush reference. Despite all of the things argued by applicant, Thrush satisfies the claimed structural limitations. Further, applicant has not pointed out why Thrush fails to anticipate the claimed structural limitations.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 2833

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tho D. Ta whose telephone number is (571) 272-2014. The examiner can normally be reached on M-F (8:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (571) 272-2800 ext 33. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



THO D. TA
PRIMARY EXAMINER

tdt
05/29/06